

Jayanta Roy-Chowdhury et al.

Serial No. 08/808,629

Filed: February 28, 1997

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Preliminary Amendment Of Elected Claims (Prior To Their Examination
- March 11, 1999)

REMARKS

This is a response to the restriction requirement dated March 3, 1999 and a preliminary amendment of the claims elected in the restriction response.

The Restriction Requirement Under 35 U.S.C. §121

In the March 3, 1999 Office Action, the Examiner required restriction under 35 U.S.C. 121 to one of the following inventions:

- I. Claims 1-14, 16-27, 29-40, 42-55, 57-74, and 76-120, drawn to a method for producing selective immune down regulation, classified in class 424, subclass 199.1.
- II. Claims 15, 28, 41, 56, and 75, drawn to a kit, classified in class 435, subclass 975.
- III. Claims 121-125, drawn to a transplantation method, classified in class 514, subclass 44.

In the Office Action (page 2), the Examiner stated:

The inventions are distinct, each from the other because of the following reasons: Inventions I-III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions. The method for producing selective immune down regulation is a different function from the method of transplantation. Furthermore, the function of the kit is for commercialization purposes.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, searches, recognized divergent subject matter, restriction for examination purposes as indicated is proper.

The Examiner continued on pages 3 and 4:

This application contains claims directed to the following patentably distinct species of the claimed invention:

- (a) viral
- (b) non-viral

Applicant is required under 35 U.S.C. 121 to elect a single

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disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicants hereby elect the invention of Group III, claims 121-125, drawn to a transplantation method. Applicants also elect the viral species as set forth in the species election.

Before closing on issue of invention restriction and species election, Applicants would like to point out that in view of the Examiner's restriction requirement, each of the three groups of claims is not only distinct from the other two, but moreover, is a separate and independent invention from the other.

Having elected Group III and claims 121-125 for prosecution in this application, Applicants request that the addition of the new claims given below.

KINDLY AMEND THIS APPLICATION AS FOLLOWS:

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SUMMARY AND CONCLUSION

Claims 1-125 were previously pending in this application. In response to the restriction requirement, Applicants have canceled the non-elected claims of Groups I and II, claims 1-120, such claims to be pursued in divisional applications. New claims 126-155 have been added. Accordingly, claims 121-155 are presented for examination in this application.

No fee is believed due for newly added claims 126-155, the cost of those claims having been offset by the cancellation of claims 1-120. In the event that any fee or fees are due, The Patent and Trademark Office is authorized to charge Deposit Account 05-1135 for any fees required in connection with this Response and Preliminary Amendment, and to credit any overpayment therein.

If it would be helpful in expediting examination of all of the claims in this application, the Examiner is respectfully requested to telephone the undersigned attorney at (212) 583-0100 to discuss the subject application.

Respectfully submitted,



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